UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,947	07/10/2001	Gerald L. Jenkins	7663/82744	9222

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EXAMINER
REFAI, RAMSEY

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 March 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☒ Claim(s) *5, 16, 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) March 29, 2006. Claims 1, 6, 12, 17,

20, and 25 have been amended. Claims 1-27 remain pending examination.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

Claim 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claim s 1, 6, 12, 17, 20, and 25 recite the limitation "the Internet account holder".

There is insufficient antecedent basis for this limitation in the claim.

Since the claims 2-5, 7-11, 13-16, 18-19, 21-24, and 26-27 depend on the above rejected claims,

these claims are also rejected under the same rationale.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

3.   Claims 1-3, 6, 8, 12-14, 17, 19-22, 25, and 27 are rejected under 35 U.S.C. 102(b) as

being anticipated by Ronen ('USPN 5,845,267).

4.   Regarding claims 1 and 12, Ronen (USPN 5,845,267) teaches a system for enabling a

server to contact an unknown Internet account holder, the Internet account holder being a person

or entity responsible for an account for Internet access; comprising:

a. Receiving a notice from the server via a standardized communication pathway, the notice comprising a request time and a requesting IP address, and a communication (column 7, line 65 - column 8, line 1; column 5, lines 38-40).

b. Identifying the account holder based on the requesting IP address and optionally the request time (column 8, lines 1-4).

c. Sending the account holder the communication by an arranged manner (column 8, lines 24-29).

d. Wherein the server need not know the identity of the account holder, and the notice need not contain information regarding the identity of the account holder (column 7, line 65 - column 8, line 1; column 5, lines 38-40). Please note that the server (merchant ISP) only has the IP address of the request. The transaction server and billing server correlate this to a user ID, the merchant server never sees the user ID.

5.   Regarding claims 2 and 13, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 1 and 12, respectively. He further teaches means wherein the step of identifying the account holder comprises checking a list of static IP addresses (column 5, lines 46-48).

6.   Regarding claims 3, 14, and 22, Ronen (USPN 5,845,267) teaches all the limitations as applied to claims 1, 12, and 21, respectively. He further teaches means wherein the arranged manner is selected from the group consisting of email, fax, voice, standard mail, and destruction (column 7, line 65 - column 8, line 1; column 5, lines 3840). Note that the billing server would notify the user, if a credit card were billed, standard mail would be used to send the bill.

7.   Regarding claims 6, 17, and 25, Ronen (USPN 5,845,267) teaches a system for enabling a server to contact an unknown Internet account holder, the Internet account holder being a person or entity responsible for an account for Internet access, with means for:

a. Receiving a request for a resource (column 7, lines 65-66).

b. Determining that the request for the resource warrants sending a notice to an account

holder (column 7, line 65 - column 8, line 1). Please note that the transaction server determines

this and forwards a message to the session server.

c. Identifying a notice destination to which the notice is to be sent (column 8, liens 4-10).

The session server is the destination in this case.

d. Generating a notice comprising an apparent IP address, a time the server received the

request, and a communication (column 8, lines 410). The transaction server queries the session

server.

e. Sending the notice to the notice destination via a standardized communications

pathway (column 8, lines 4-10). The request is sent to the session server.

8.   Regarding claim 8, Ronen (USPN 5,845,267) teaches all the limitations as applied to

claim 6. He further teaches wherein the server is a web server that is sending a response to an http

request (figure 1, element 121; column 8, lines 4-10).

9.   Regarding claims 19 and 27, Ronen (USPN 5,845,267) teaches all the limitations as

applied to claims 17 and 25. He further teaches wherein the resource is an http resource (figure 1,

element 121; column 8, lines 4-10).

10.   Regarding claim 20, Ronen (USPN 5,845,267) teaches a system for enabling a server to

contact an unknown Internet account holder, the Internet account holder being a person or entity

responsible for an account for Internet access; comprising:

a. A standardized communication pathway server capable of receiving a notice (column

7, line 65 -column 8, line 1; column 5, lines 38-40).

b. A parser capable of identifying a request time, a requesting IP address from the notice

and communication within the notice (column 8, lines 14).

c. A login database comprising IP addresses, request times, and accounts (column 4, line

63 - column 5, line 1).

d. Account holder communication subsystem for sending the account holder the

communication (column 8, lines 24-29).

e. Wherein the server need not know the identity of the account holder, and the notice

need not contain information regarding the identity of the account holder (column 7, line 65 -

column 8, line 1; column 5, lines 38-40). Please note that the server (merchant ISP) only has the

IP address of the request. The transaction server and billing server correlate this to a user ID, the

merchant server never sees the user ID.

11.   Regarding claim 21, Ronen (USPN 5,845,267) teaches all the limitations as applied to

claims 1 and 12, respectively. He further teaches means wherein the login database comprises a

list of static IP addresses (column 5, lines 46-48).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such
> that the subject matter as a whole would have been obvious at the time the invention was made to a person having
> ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in
> which the invention was made.

13.   Claims 4, 11, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ronen (USPN 5,845,267) in view of Grassle (USPN 6,785,824).

14.   Regarding claim 4, Ronen (USPN 5,845,267) teaches all the limitations as applied to

claim 1. He further teaches means for checking one or more files comprising a database

comprising dynamic IP addresses, accounts, and times, and the request time is the time at which

the server received the requests (column 8, lines 1-4). Although the system disclosed by Ronen

(USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose

specifically means wherein the communication pathway is email. Nonetheless, these features are

well known in the art and it would have been an obvious modification of the system disclosed by

Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

15.   Regarding claim 11, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claim 6) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway is email. Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standard communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

16.   Regarding claim 15, Ronen (USPN 5,845,2677 teaches all the limitations as applied to claim 12. He further teaches means for identifying an account holder using dynamic IP addresses, accounts, and times, and the request time is the time at which the server received the requests (column 8, lines 1-4).

Although the system disclosed by Ronen (USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway is email.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standardized communication pathway is email (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user. 2

17.   Regarding claim 23, Ronen (USPN 5,845,267) teaches all the limitations as applied to claim 21. He further teaches means wherein the login database comprises dynamic IP addresses, accounts, and times (column 8, lines 1-4).

Although the system disclosed by Ronen (USPN 5,845,267) shows substantial features of the claimed invention, it fails to disclose specifically means wherein the standardized communication pathway server is an email server.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Grassle (USPN 6,785,824).

In an analogous art, Grassle (USPN 6,785,824) discloses a system for sending messages based on Internet usage wherein the standardized communication pathway server is an email server (figure 2, element 108).

Given the teaching of Grassle (USPN 6,785,824), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing email for contacting a user. This is a common form of communication on the Internet and benefits the system by making the message immediately available to a user.

18.   Claims 7, 10, 18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (USPN 5,845,267) in view of McClain et al. (USPN 6,722,214).

19.   Regarding claims 7, 18, and 26, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claims 6, 17, and 25, respectively) shows substantial features of the claimed invention, it fails to disclose means for warning a user that fulfilling the request for a resource will result in the sending of a notice.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by McClain et al. (USPN 6,722,214).\

In an analogous art, McClain et al. (USPN 6,722,214) discloses a system for evaluating web requests with means for warning a user that fulfilling the request for a resource will result in the sending of a notice (column 11, lines 20-25).

Given the teaching of McClain et al, (USPN 6,722,214), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by employing the warning of users that a notice may be sent. This benefits the system by allowing a user to choose not to access content or purchase something if it is known that charges will be incurred or if the material is inappropriate.

20.   Regarding claim 10, although the system disclosed by Ronen (USPN 5,845,267) (as applied to claim 8) shows substantial features of the claimed invention, it fails to disclose means wherein the response to the hypertext transfer protocol request contains hypertext code that enables a caching server to send notices on behalf of the server.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by McClain et

al. (USPN 6,722,214).

In an analogous art, McClain et al. (USPN 6,722,214) discloses a system for evaluating

web requests wherein the response to the hypertext transfer protocol request contains hypertext

code that enables a caching server to send notices on behalf of the server (abstract; column 11,

lines 20-25).

Given the teaching of McClain et al. (USPN 6,722,214), a person having ordinary skill in

the art would have readily recognized the desirability and advantages of modifying Ronen (USPN

5,845,267) by employing a cache server that can send messages in place of the origin server. This

benefits the system by ensuring that cached data is protected from inappropriate access or charges

even though it is not newly downloaded from the server.

21.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (USPN

5,845,267) in view of Forlenza et al. (USPN 6,725,380).

22.   Regarding claim 9, although the system disclosed by Ronen (USPN 5,845,267) (as

applied to claim 8) shows substantial features of the claimed invention, it fails to disclose means

wherein the response to the hypertext transfer protocol request contains hypertext code that aids

in preventing the caching of the Web page.

Nonetheless, these features are well known in the art and it would have been an obvious

modification of the system disclosed by Ronen (USPN 5,845,267), as evidenced by Forlenza et

al. (USPN 6,725,380).

In an analogous art, Forlenza et al. (USPN 6,725,380) discloses a system for ensuring

security in Internet usage wherein the response to the hypertext transfer protocol request contains

hypertext code that aids in preventing the caching of the Web page (column 7, lines 16-21).

Given the teaching of Forlenza et al. (USPN 6,725,380), a person having ordinary ski!! in the art would have readily recognized the desirability and advantages of modifying Ronen (USPN 5,845,267) by preventing the caching of some content. This benefits the system by protecting the user from future accesses of inappropriate or personal information.

Allowable Subject Matter

23.   Claims 5, 16 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

24.   Applicant's arguments filed June 9, 2005 have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues in substance that Ronen does not teach newly added limitation "the Internet account holder being a person or entity responsible for an account for Internet access".

- In response to applicant's arguments, the recitation "the Internet account holder being a person or entity responsible for an account for Internet access" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
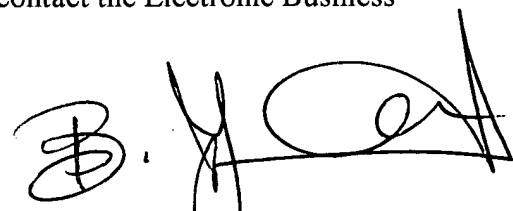
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
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SUPERVISORY PATENT EXAMINER